

REMARKS

Reconsideration of the Final Office action mailed February 14, 2006 is requested in view of the foregoing amendments and the following remarks.

Claim Rejections – 35 USC § 103

Claim 13 was rejected under 35 USC §103(a) as obvious in light of Laskowski (US Patent 4,559,858) combined with Yoneda (US Patent 4,117,752). That rejection is traversed because the references fail to disclose all the limitations of claim 13 and because there is no suggestion to combine the references. Nevertheless, applicant has cancelled claim 13 without prejudice in order to simplify the issues for appeal.

Allowable Subject Matter

The Examiner stated, "It should be noted that claim 15 has not been rejected over prior art." (Final Office action mailed 2-14-06, p. 4.) Thus, claim 15 recites allowable subject matter. However, the Examiner did not allow the claim because of an obviousness-type double patenting rejection. Applicant believes the double-patenting rejection should be withdrawn because a two-way test for obviousness should have been applied, as explained below.

Double Patenting

The Examiner rejected claim 15 under the judicially created doctrine of obviousness-type double patenting in light of claim 12 from US Patent 6,944,004 (application 10/052,705). As stated, this rejection should be withdrawn because a two-way test for obviousness should have been applied.

Section 804(II)(B)(1)(b) from the MPEP explains:

[W]here, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office.

This rule is taken from the case of In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). In that case, the Board of Patent Appeals and Interferences affirmed an obviousness-type double patenting rejection of an earlier-filed application in view of a commonly-assigned but later-filed patent. Both the application and the patent concerned optical record carriers such as CDs. The Board applied a one-way test for obviousness and determined that the claims at issue from the earlier-filed application were obvious in light of claims from the later-filed patent. The Federal Circuit reversed and explained that a two-way test should have been applied because the two applications could not have been filed together as one, because it was not applicant's fault that the later-filed application issued first, and because the later-filed claims were not obvious in light of the earlier-filed claims. Id. at 594, 19 USPQ2d at 1293. The court explained that the rationale behind the application of the two-way test "is that an applicant (or applicants), who files applications for basic and improvement patents should not be penalized by the rate of progress of the applications through the PTO, a matter over which the applicant does not have complete control." Id. at 593, 19 USPQ2d at 1292 (citing 3 D. Chisum, *Patents*, 9.03[2][c] (1990), and the following cases: In re Borah, 345 F.2d 1009, 148 USPQ 213 (CCPA 1966), In re Stanley, 214 F.2d 151, 102 USPQ 234 (CCPA 1954), In re Calvert, 97 F.2d 638, 38 USPQ 184 (CCPA 1938), Thomson-Houston Elec. Co. v. Elmira & Horseheads Ry. Co., 71 F. 396 (2d Cir.), *cert. denied* 163 U.S. 685, 16 S.Ct.

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1201, 41 L.Ed.2d 315 (1896), Thomson-Houston Elec. Co. v. Ohio Brass Co., 80 F. 712 (6th Cir. 1897)).

The case of In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), further explains when a two-way test applies. In Berg, the Federal Circuit affirmed a one-way double patenting rejection of genus claims in light of nearly identical species claims. The claims concerned a method of preparing abrasive particles for use as an abrasive grit. The genus and species claims were the subject of two separate applications filed the same day. The species claims issued first and the Patent Office applied a one-way test to reject the genus claims in light of the species claims. The court affirmed the double patenting rejection and the application of the one-way test because Berg could have filed all the claims in a single application but instead chose to file two separate applications on the same day. Id. at 1433, 46 USPQ2d at 1230.

Even though Berg affirmed the application of the one-way test, the court recognized that the two-way test applies when a later-filed improvement patent issues before an earlier-filed basic invention. Specifically, the court distinguished Braat by saying: "Braat ... emphasized the more typical scenario in which, despite common inventive entities, the two-way test applied: 'when a later-filed improvement patent issues before an earlier filed basic invention.'" Id. at 1434, 46 USPQ2d at 1230 (quoting In re Braat, 937 F.2d at 593, 19 USPQ2d at 1292, emphasis added in Berg). The court in Berg also said the "essential concern" behind the two-way test "was to prevent rejections for obviousness-type double patenting when the applicants filed first for a basic invention and later for an improvement, but, through no fault of the applicants, the PTO decided the applications in reverse order of filing, rejecting the basic application

although it would have been allowed if the applications had been decided in the order of their filing." Id. at 1432, 46 USPQ2d at 1229. These statements confirm that the two-way test applies when a later-filed improvement patent issues before an earlier-filed application through no fault of applicant.

The situation in the present application is the same as in Braat and as described in Berg, and therefore, the two-way test for obviousness should apply. The present application was filed before the cited patent and the cited patent could not have been filed with the present application because it includes additional disclosure of later-developed material. In fact, the cited patent is a continuation-in-part of the present application.

Applying the two-way test to the case at hand shows that there is no double patenting. Claim 12 in the cited patent recites a brake positioning system that "includes a positioning member configured to maintain the brake mechanism adjacent the blade, where the positioning member is elongated with one end adjacent the arbor and the other end adjacent the brake mechanism, and where the positioning member is configured to pivot around the arbor." Claim 12 also says "the brake mechanism is adjacent the back of the blade," and specifies that "the brake mechanism being adjacent the back of the blade tends to cause the blade to move at least slightly downward relative to the table when the brake mechanism engages the blade." None of that structure is recited in pending claim 15. Instead, claim 15 in the present application recites "brake positioning means for moving the brake means up and down with the blade to maintain the brake means in an operative position relative to the blade as the position of the blade is adjusted up and down." Nothing in claim 12 from the cited patent

requires moving a brake up and down with the blade. Thus, the claims at issue are patentably distinct and there is no double patenting.

Withdrawal of Finality

Applicant requests that the finality of the Office action mailed February 14, 2006 be withdrawn because the Examiner introduced a new ground of rejection that was neither necessitated by an amendment nor based on recently submitted information. Specifically, claim 13 was rejected as obvious in light of Laskowski combined with Yoneda, as stated. That was a new ground of rejection. Claim 13 previously was rejected as obvious in light of Tannewitz (US Patent 1,811,066) combined with Lokey (US Patent 3,785,230), but that rejection was withdrawn. Claim 13 was not amended in any way to necessitate the new rejection. Also, the Yoneda reference was disclosed previously and the Laskowski reference was recently found by the examiner. Finally, the Examiner recognized there was a new ground of rejection by saying that applicant's prior arguments had been considered but were "moot in view of the new ground(s) of rejection." (Final Office action mailed 2/14/06, p. 4.) Accordingly, applicant requests that the finality of the last rejection be withdrawn and that this amendment be entered as responsive to the last Office action. See MPEP 706.07(a) et seq.

New Claim

Applicant is adding new claim 34 which is similar to claim 15 except that it does not include means-plus-function limitations. Claim 34 should be allowed for the same reasons as claim 15.

Conclusion

With entry of the above amendments, and for the reasons discussed herein, applicant submits that all of the issues raised in the Final Office action mailed February 14, 2006 have been addressed and overcome.

Respectfully submitted,

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